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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LUTZ ROSENPFLANZER, RICHARD LEBLANC, and
RALF STEUERNAGEL

Appeal 2009-005206
Application 10/607,102
Technology Center 2100

Decided: January 26, 2010

Before LANCE LEONARD BARRY, STEPHEN C. SIU, and
DEBRA K. STEPHENS *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-30. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Invention

The invention relates to managing the different representations of information used by different data processing devices (Spec. 1, ll. 5-6).

Independent claim 1 is illustrative:

1. A computer-implemented method for managing different representations of information, comprising:

receiving information describing a first representation of data variable information in a first data structure in a first data processing system;

receiving information describing a second representation of the data variable information in the first data structure in a second data processing system; and

mapping the first representation of the data variable information to the second representation of the data variable information, the mapping comprising:

identifying a correspondence between the first representation and the second representation using a set of data processing activities performed in accordance with a first set of machine-readable instructions, representing the correspondence using the set of data processing activities performed in accordance with the first set of machine-readable instructions, and

making the correspondence between the first representation and the second representation available for changing the first

representation of the data variable
information to the second representation of
the data variable information.

References

The Examiner relies upon the following references as evidence in support of the rejection:

Granade US 2002/0103881 A1 Aug. 1, 2002

Susan L. Graham, et al., *An Experiment in Table Driven Code Generation*, Proceedings of the 1982 Sigplan Symposium on Compiler Construction, Boston, MA, pp. 32-43 (June 1982) (“Graham”).

C. Van Reeuwijk, *Tm: a Code Generator for Recursive Data Structures*, Software-Practice and Experience, vol. 22:10, pp. 899-908 (October 1992) (“Reeuwijk”).

XSL Transformations (XSLT) Version 1.0, W3C Recommendation 16 November 1999 (“XSLT”).

Rejections

Claims 1-14, 22-25, and 30¹ are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description and enablement requirements.

¹ Appellants (App. Br. 5) and the Examiner (Ans. 4-5) do not list claim 30 as part of the 35 U.S.C. § 112 rejections. However, claim 30 depends on and incorporates all of the limitations of claim 1. This failure to list claim 30 as part of the 35 U.S.C. § 112 rejections appears to be mere oversight with no substantive impact.

Claims 1-14, 22-25, and 30¹ are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter Appellants regard as the invention.

Claims 1-4, 7, and 9-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by Granade.

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Granade and Reeuwijk.

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Granade and Graham.

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Granade and XSLT.

ISSUE 1

The Examiner finds that “[i]t is unclear what a set of data processing activities is” (Ans. 5) and therefore concludes claims 1-14 and 22-25 to be indefinite.

Appellants submit that “[t]he meaning of the term ‘data processing activities’ is clearly discernable to those of ordinary skill” (App. Br. 12).

Issue: Did Appellants demonstrate that the Examiner erred in concluding that the term “data processing activities” is indefinite?

ISSUE 2

The Examiner holds that the Specification “does not disclose that the identifying and representing is performed ‘using a set of data processing”

activities . . .” (Ans. 4) and also “does not enable any person skilled in the art . . . to make and use the invention” (*id.*).

Appellants argue that the Specification provides “detail[s] regarding implementations of the identification and representation of correspondence between data variable information in a first data structure in different data processing systems” (App. Br. 11).

Issue: Did Appellants demonstrate that the Examiner erred in concluding that the Specification lacks adequate written description and fails to enable one of skill in the art to make and use the invention?

ISSUE 3

Appellants argue that claims 1 and 15 are “not anticipated by Granade” (App. Br. 20, 22).

Issue: Did Appellants demonstrate that the Examiner erred in finding that Granade teaches limitations recited in claims 1 and 15?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

1. The Specification discloses that
[i]n mapping, the integration engine can identify and represent the correspondence between the customization settings, and hence the customization of data variable, in the first and second systems. The resulting representation of the correspondence between the customization settings can be machine-readable instructions for changing the representation of a data

object in the first system into the representation of the same data object in a second system.

(Spec. 9, ll. 3-8).

2. The Specification discloses that

[t]he system can insert instructions for identifying objects of a selected object class in a data structure (such as objects in an XML [Extensible Markup Language] document). The system can insert instructions for locating the customization settings of a source and a target system, for example in the source and target systems themselves. The system can insert instructions for representing the correspondence between customization settings. For example, the system can insert information that identifies specific Java calls for transforming objects represented in accordance with a source system's customization settings into objects represented in accordance with a target system's customization settings. The inserted Java calls can be from namespaces included in the XSL [Extensible Stylesheet Language] document.

(Spec. 11, ll. 12-20).

3. The Specification discloses that “[d]ata processing systems 105, 110, 115 can operate autonomously, handling local workloads of data processing activities” (p. 5, ll. 17-19). “Data are machine-readable representations of information” (*id.*, ll. 20-21). “Data processing systems 105, 110, 115 can be devices or groups of devices that perform data processing activities in accordance with the logic of a set of machine-readable instructions” (*id.*, ll. 26-27).

4. Granade teaches that

[f]or data communication, mobile presentation server 114 selects one of WML [Wireless Markup Language] 310, HDML [Handheld Device Markup Language] 312, HTML [Hyper Text Markup Language] 314, or other data device adaptor 316 to transmit data information to a display associated with mobile device 106. Each different data device adaptor may require mobile presentation server 114 to access application repository 116 for details on rendering different protocols or languages properly on the mobile device display.

(¶ [0046]).

5. Granade teaches that

results from various backend systems 102 are converted to an intermediary language compatible with XML and passed to mobile presentation server 114 for adaptation to the particular mobile device. Mobile presentation server 114 identifies the characteristics of the mobile device including display size and browser type and modifies the information for presentation on the mobile device in the most suitable format. For example, mobile presentation server 114 can modify the resolution of an image to fit the display of a particular mobile device.

(¶ [0029]).

6. Granade teaches

automatically translating the default language in the application into the language associated with the desired locale [on a particular mobile device]. This latter implementation may also automatically perform currency translations between a default currency used by the application and the currency in the desired locale.

(¶ [0038]).

PRINCIPLES OF LAW

Definiteness

Under the first and second paragraphs of 35 U.S.C. § 112, the first inquiry “is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity.” *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

Written description

After determining that the patent claims are particular and definite, the second inquiry is “whether the scope of protection sought is supported and justified by the specification disclosure.” *Moore*, 439 F.2d at 1235.

To comply with the “written description” requirement of 35 U.S.C. § 112, first paragraph, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the claimed invention. “One shows that one is ‘in possession’ of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). The specification need not describe the

claimed subject matter in exactly the same terms as used in the claims, but it must contain an equivalent description of the claimed subject matter. *Id.*

Enablement

It is relatively simple for an inventor to comply with the written description requirement. *Moore*, 439 F.2d at 1236. This requirement will ordinarily demand minimal concern. *Id.* “What is of maximum concern . . . is whether [the] disclosure contains sufficient teaching[s] regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and to use the claimed invention.” *Id.* “The relevant inquiry may be summed up as being whether the scope of enablement provided to one of ordinary skill in the art by the disclosure is such as to be commensurate with the scope of protection sought by the claims.” *Id.*

“[E]nablement requires that the specification teach those in the art to make and use the invention without undue experimentation.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Factors to be considered in determining whether undue experimentation would be required include: “(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.” *Id.*

Claim interpretation

Applicants can use either “said” or “the” in patent claims to create anaphoric phrases. *Baldwin Graphics Systems, Inc. v. Siebert, Inc.*, 512 F.3d 1338, 1343 (Fed. Cir. 2008). Such phrases generally refer back to an initial antecedent phrase—itsself usually prefaced with an indefinite article. *Id.*

“[T]he patentee’s mere use of a term with an antecedent does not require that both terms have the same meaning.” *Microprocessor Enhancement Corp. v. Texas Instruments Inc.*, 520 F.3d 1367, 1375 (Fed. Cir. 2008). However, “[a] word or phrase *used consistently* throughout a claim should be *interpreted consistently*.” *Id.* (citations omitted).

Anticipation

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted). “[I]f granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (citation omitted).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art,

(2) any differences between the claimed subject matter and the prior art, and
(3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

ANALYSIS

Issue 1

The Examiner holds that “[i]t is unclear what a set of data processing activities is and how this set is used to identify and/or represent the correspondence” (Ans. 5). Appellants argue that that, “there is no reason to believe that the meaning of the phrase ‘data processing activities’ would not be discernable to those of ordinary skill” (App. Br. 13).

Here, the Specification teaches that data processing systems are devices that can perform data processing activities (FF 3). Data means “machine-readable representations of information” (*id.*). Activities for processing are those specified by “the logic of machine-readable instructions” (*id.*). Thus, data processing activities means executing machine-readable instructions to process machine-readable representations of information. This meaning is sufficiently clear to apprise an artisan of ordinary skill of the claim scope with sufficient precision and particularity. *See Moore*, 439 F.2d at 1235.

For at least these reasons, we find that Appellants have sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner’s 35 U.S.C. § 112, second paragraph, rejections of claims 1-14, 22-25, and 30.

Issue 2

The Examiner concludes that the Specification does not disclose and enable identifying and representing correspondences using a set of data processing activities (Ans. 4). Appellants identify several portions of the Specification allegedly providing the requisite enabling disclosure (App. Br. 11).

Appellants claimed mapping includes both identifying and representing a correspondence (claim 1). The Specification discloses that an integration engine can identify and represent the correspondence between customization settings, and data variables, in a first and second system (FF 1). The representation of the correspondence between customization settings can be machine-readable instructions (*id.*). Such instructions can include specific Java calls for transforming objects in accordance with source and target system customization settings (FF 2). The system can also insert instructions for identifying objects (*id.*).

These teachings disclose the use of data processing activities (e.g., Java calls) to represent a correspondence. These teachings also disclose the use of data processing activities (e.g., interpreting machine-readable instructions in general) to identify a correspondence (claim 1). Appellants have thus demonstrated where the Specification teaches identifying and representing a correspondence using data processing activities.

The Examiner further concludes that the Specification, while enabling for identifying “correspondence between . . . settings . . . in the first and second systems” (Ans. 4), is nevertheless not enabling for identifying

“correspondence between . . . [settings] using a set of data processing activities” (*id.*). As set forth above, enablement requires that the specification teach those in the art to make and use the invention without “undue experimentation.” *Wands*, 858 F.2d at 737. Hence, the Examiner maintains that one of ordinary skill in the art would have had to engage in undue experimentation to use “a set of data processing activities.”

We find that the Examiner has failed to provide a showing that the Specification combined with the knowledge of a skilled artisan would have been insufficient to enable one of skill in the art to use a set of data processing activities without undue experimentation. While the Examiner concludes generally that it would have been necessary for one of ordinary skill to exercise undue experimentation in order to perform “a set of data processing activities,” the Examiner does not provide support for this conclusion. For example, the Examiner fails to address the *Wands* factors or provide a discussion of “the relative skill of those in the art”, and “the predictability or unpredictability of the art” (*Wands*, 858 F.2d at 737), which would have been particularly helpful.

While “it is not necessary that a court review all the *Wands* factors to find a disclosure enabling” *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1213 (Fed. Cir. 1991), we find that the findings enumerated by the Examiner in lieu of a discussion of the *Wands* factors fail to demonstrate that undue experimentation would have been necessary on the part of one of ordinary skill in the art to perform “data processing activities.”

For at least these reasons, we find that Appellants have sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's 35 U.S.C. § 112, first paragraph, rejections of claims 1-14, 22-25, and 30.

Issue 3

Appellants argue that “claim 1 recites that information describing different representations of the *same data variable information* in the *same first data structure* in *different data processing systems* is received and the correspondence therebetween mapped” (App. Br. 16) and that “the WML, HDML, or HTML files of the mobile device cannot be the same first data structure” (Reply Br. 3) as the Examiner finds. Similarly, Appellants argue that “only a single data structure is recited in claim 15, and . . . an XML file in a server and a WML, HDML, or HTML file in a mobile device cannot represent a single data structure” (Reply Br. 4). The Examiner holds that Appellants' claims require two different structures (Ans. 20-21). We agree with Appellants.

Granade teaches that the mobile presentation server uses WML, HDML, HTML, and other formats to transmit data content (i.e., “data variable information”) to a display associated with a mobile device (FF 4) such that the data is modified or translated for the mobile device (FF 5-6). Since the mobile presentation server of Granade formats the “data variable information” prior to transmitting, the data variable information does not exist on the target mobile device until after the mobile presentation server

formats the data variable information. Therefore, the received representation information cannot describe the representation of the same information found in the same data structure of a first data processing system.

For at least these reasons, we find that Appellants have sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's 35 U.S.C. § 102(e) rejection of claims 1-4, 7, and 9-30 and in the Examiner's 35 U.S.C. § 103(a) rejections of claims 5, 6, and 8.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have demonstrated:

1. that the Examiner erred in concluding that the term "data processing activities" is indefinite (Issue 1);
2. that the Examiner erred in concluding that the Specification lacks adequate written description and fails to enable one of skill in the art to make and use the invention (Issue 2); and
3. that the Examiner erred in finding that Granade teaches limitations recited in claims 1 and 15 (Issue 3).

DECISION

We reverse the Examiner's rejection of claims 1-14, 22-25, and 30 under 35 U.S.C. § 112, first and second paragraphs, claims 1-4, 7, 9-30 under 35 U.S.C. § 102(e), and claims 5, 6, and 8 under 35 U.S.C. § 103(a).

REVERSED

Appeal 2009-005206
Application 10/607,102

msc

SCHWEGMAN, LUNDBERG & WOESSNER/SAP
P.O. BOX 2938
MINNEAPOLIS MN 55402